

REMARKS

In the Office Action¹, the Examiner took the following actions:

rejected claims 25 and 26 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

rejected claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,697,865 to Howard et al. ("*Howard*"); and

rejected claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of U.S. Patent Application Publication No. 2002/0138331 to Hosea et al. ("*Hosea*").

By the present amendment Applicant has amended the specification to correct typographical errors and has amended claims 1 and 25-26 to more appropriately define the invention. Claims 1-26 remain pending in this application.

I. Rejection of claims 25 and 26 under 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner rejects claims 25 and 26 under 35 U.S.C. § 101 and states that "the claimed invention is directed to non-statutory subject matter." Applicant respectfully traverses the rejection of claims 25 and 26. However, to expedite prosecution, Applicant has amended claims 25 and 26 to recite "a machine-readable storage medium including machine-readable instructions which when executed on a processor, cause the processor to:" thereby, even more clearly reciting statutory subject matter. Therefore, claims 25 and 26 fall within the categories of patentable subject matter, and Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 25 and 26 under 35 U.S.C. §101.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant decline to automatically subscribe to any statement or characterization in the Office Action.

II. Rejection of claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e) as being as being anticipated by *Howard*

Applicant respectfully traverses the rejections of claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e), as being anticipated by *Howard*. In order to properly establish that *Howard* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites, among other things "associating at least a portion of the context information from the one or more entity profiles to the user profile by importing at least the portion of the context information into the user profile" (emphases added). *Howard* does not disclose at least these elements of Applicant's claimed invention.

Howard teaches a system in which "[i]nformation is stored that reflects the existence of relationships between identified parties with respect to use of the digital facility. A predetermined type of interaction of the parties is permitted) via the electronic communication medium with respect to the digital facility if the stored information reflects the existence of relationships between them," (abstract). In another part of *Howard* it is explained that "[a] user profile may include demographic data; permissions given to the user to create and manage the profiles of other users and companies; a list of permissions given to the user with respect to other objects in the system; a list of preferences of the user for his personal relationship portal," (col. 4, lines 36-40). User

profiles in *Howard* are given permission to perform predetermined types of interactions based on information stored in the digital facility. Such a disclosure does not constitute “associating at least a portion of the context information from the one or more entity profiles to the user profile by importing at least the portion of the context information into the user profile,” (emphases added) as recited in claim 1. In particular, such a disclosure does not teach or suggest the claimed “user profile” including “at least the portion of the context information” because, at most, *Howard* teaches giving permission to user profiles based on information stored in the digital facility.

The Examiner cites column 4, lines 45-51 for an alleged teaching of the above-recited claim elements. See Office Action, page 4. The Examiner’s allegation is incorrect. *Howard* teaches “[i]n one implementation, the maximum permissions available to a user are limited by the permissions assigned to the user’s company,” (column 4, lines 44-47). Such a disclosure does not constitute “importing at least the portion of the context information into the user profile,” (emphasis added) as recited in claim 1. Even assuming that giving permissions to user profiles of *Howard* could constitute the claimed “context information,” which Applicant does not concede, at most, *Howard* teaches limiting permissions available to a user by permissions assigned to the user’s company and does not teach importing at least the portion of the context information into the user profile. Neither the cited portion nor any other portion of *Howard* teaches importing context information into the user profile.

Therefore, *Howard* does not teach or suggest the claimed limitations including, for example, “associating at least a portion of the context information from the one or

more entity profiles to the user profile by importing at least the portion of the context information into the user profile" (emphases added) as recited in claim 1.

Accordingly, *Howard* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons.

Independent claims 14, 25, and 26 while of different scope, recite elements similar to those of claim 1 and are thus allowable over *Howard* for at least the same reasons discussed above in regard to claim 1. Claims 2-4, 8-9, 12-13, 15, and 19-22 are also allowable at least due to their dependence from claims 1 and 14.

III. Rejection of claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Hosea*

Applicant respectfully traverses the rejection of claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Hosea*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and

the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Claims 5-7, 10-11, 16-18, and 23-24 depends from claims 1 and 14 and thus requires all elements of claims 1 and 14. As set forth above *Howard* does not disclose each and every element recited in claims 1 and 14 and required by claims 5-7, 10-11, 16-18, and 23-24. *Hosea* fails to remedy the above-noted deficiencies of *Howard* with respect to independent claims 1 and 14. For example, *Hosea* fails to teach, suggest, or render obvious among other things “associating at least a portion of the context information from the one or more entity profiles to the user profile by importing at least the portion of the context information into the user profile” (emphases added) as recited in claims 1 and 14 and required by claims 5-7, 10-11, 16-18, and 23-24.

Here, no *prima facie* case of obviousness has been established for at least the reason that, in view of the failure of the references to teach the claimed combination, as discussed above, the Office Action has failed to properly determine the scope and

content of the prior art and has accordingly failed to properly ascertain the difference between the prior art and the matter of claims 1 and 14. Regarding the differences that have been cited, no reason has been provided as to why one of ordinary skill in the art, at the time the invention was made, would modify *Howard* or *Hosea*. Moreover, the Office Action has not identified any predictability or reasonable expectation of success of such a modification.

For this reason, the Office Action has failed to clearly articulate a reason why *Howard* and *Hosea* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 5-7, 10-11, 16-18, and 23-24.

Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 5-7, 10-11, 16-18, and 23-24.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

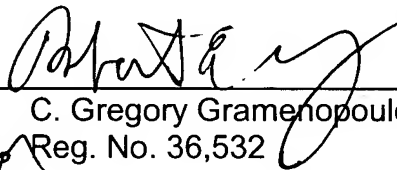
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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